

REMARKS

Favorable reconsideration is respectfully requested.

The claims are 12-20.

The above amendment presents a new set of claims responsive to points set forth in the Official Action.

New claim 12 replaces previous claim 1.

New claim 13 replaces previous claim 2.

New claims 14-16 replace previous claims 4-6, respectively.

New claim 17 replaces previous claim 7.

New claim 18 replaces previous claim 8.

New claim 19 replaces previous claim 9.

New claim 20 depends on claim 13.

The significance of these claims will become further apparent from the remarks below.

A Substitute Specification is submitted herewith making minor revisions and revisions discussed below.

Turning to Official Action paragraph 7, an amended title is provided substantially in accordance with the Examiner's suggestion.

In the title and throughout the specification the term "wetted" is replaced by the term "water-contact" and support is readily apparent throughout the specification.

Turning to the rejections of previous claims 1-9 under 35 U.S.C. § 112:

With respect to claim 1, the rejected term "wetted" has been replaced with "water-contact". It refers to water-contact instrument of the present claims (which typically comes into contact with water) and not to the presently claimed process.

With the regard to the comment that it is not clear whether the nickel coat, protective film or both wraps around the surface, it is apparent that the nickel coat wraps around the surface of the instrument and when the nickel coat is treated with the protective film, the film also coats and wraps around the nickel surface (where protection from nickel elution into water is desired).

With regard to the rejection of the term "including" in claim 2, replacement claim 13 does not includes this rejected term.

With regard to the rejection concerning claim 3, no counterpart claim is presently asserted.

With the regard to the rejection concerning claim 4, again, the term “including” is not recited in counterpart claim 14.

With regard to the rejection of claim 5 and the term “using”, such does not appear in counterpart claim 15.

With regard to the rejections of claims 6-8, the rejected terminology does not appear in counterpart claims 16-18, respectively.

With regard to the rejection of claim 9, antecedent basis for claim 19 is present in claim 18.

Claims 1-6 have been rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over JP 2002-180267 A in view of Applicants' admitted prior art.

This rejection is respectfully traversed.

The cited reference discloses in paragraph [0025] a combination of an acidic solution containing benzotriazole (exhibiting alkalinity per se) with organic acids. Since the organic acids are used as solvents (fluxing materials) for dissolving solid benzotriazole which is a solute, any of the organic acids employed by the reference are soluble in water.

When the water-soluble organic acid is mixed in an aqueous solution, the benzotriazole reacts directly with the organic acid in the aqueous solution. As a result, the protective film formation agent which has reacted with the acid component not only fails to fulfill its function, but also simultaneously induces a supernatant and a precipitate. These substances adhere to the treated workpiece to induce unevenness and specks, thereby forming discoloration.

On the other hand, in the presently claimed method, a protective film comprising a heterocyclic compound and a straight-chain fatty acid (which per se exhibits water repellency) is formed on a nickel coat of the water-contact surface of the water-contact instrument, so that the protective film is not dissolved in liquid (safe drinking water) flowing through the water-contact instrument (see paragraph [0146] of the present specification).

Since the water-soluble organic acid used in the reference is clearly an obstructive factor, the presently claimed method, which does not employ such organic acid but rather a water repellant one, cannot be obvious from the reference method.

There is nothing in the admitted prior art which overcomes this deficiency of the JP reference.

Claims 7-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 2002-180267 A1 in view of Applicants' admitted prior art, as applied to claim 1, above, further in view of EP 0 892 084 A1.

This rejection is also respectfully traversed in view of the above comments.

It is also clear that EP 0 892 084 does not overcome the above-discussed deficiencies of the JP reference.

Claims 1, 2, 4, 6, 7 and 9 have been rejected on the ground of obviousness-type double patenting as being unpatentable over claims 1, 8 and 9, of U.S. Patent No. 7,368,019 B2 in view of Applicants' admitted prior art.

In reply, a Terminal Disclaimer is submitted herewith which disclaims the terminal portion of any patent maturing from the present application which extends beyond the expiration date of commonly assigned U.S. 7,368,019.

An Information Disclosure Statement accompanies.

No further issues remaining, allowance of this application is respectfully requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact undersigned at the telephone number below.

Respectfully submitted,

Norikazu SUGAYA et al.

By 

Matthew M. Jacob
Registration No. 25,154
Attorney for Applicants

MJ/kjf
Washington, D.C. 20005-1503
Telephone (202) 721-8200
Facsimile (202) 721-8250
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